

MAR 23 2005

CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence, totaling 8 pages including recited attachments, is being facsimile transmitted to the United States Patent and Trademark Office at facsimile no.: 703-872-9306 (Central number) on the below date.

Date: March 23, 2005 Name: David W. Okey, Esq. Signature: *David W. Okey*BRINKS
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& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Kishore Swaminathan et al.

Appln. No.: 10/821,629

Filed: April 9, 2004

For: Knowledge Management Tool

Examiner: Not Assigned

Art Unit: 2172

Attorney Docket No: 10022/436

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Second Supplemental Information Disclosure Statement (1 cited reference); PTO 1449 (1 sheet)
- ☐ Return Receipt Postcard

Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

				Small Entity			Not a Small Entity		
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 100=			x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=			+ \$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

March 23, 2005
Date

Respectfully submitted,

David W. Okey
David W. Okey, Esq. (Reg. No. 42,959)



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RECEIVED

December 23, 2004

CASSAN MACLEAN
401- 80 Aberdeen Street
OTTAWA Ontario
K1S 5R5

DEC 30 2004

Cassan Maclean

Application No. : 2,402,253
Owner : ACCENTURE LLP
**Title : METHOD OF MANUFACTURE FOR A KNOWLEDGE
MANAGEMENT TOOL**
Classification : G06F-17/00
Your File No. : 37268-0469
Examiner : Kristy Hyam

YOU ARE HEREBY NOTIFIED OF :

- A REQUISITION BY THE EXAMINER IN ACCORDANCE WITH SUBSECTION 30(2) OF THE *PATENT RULES*;
- A REQUISITION BY THE EXAMINER IN ACCORDANCE WITH SECTION 29 OF THE *PATENT RULES*.

IN ORDER TO AVOID MULTIPLE ABANDONMENTS UNDER PARAGRAPH 73(1)(A) OF THE *PATENT ACT*, A WRITTEN REPLY TO EACH REQUISITION MUST BE RECEIVED WITHIN 6 MONTHS AFTER THE ABOVE DATE.

This application has been examined taking into account the:

Description, as originally filed;
Claims, as originally filed;
Drawings, as originally filed.

This application has been examined taking into account applicant's correspondence on prior art received in this office on July 2, 2003.

The number of claims in this application is 27.

The examiner has identified the following defects in the application:

The claims are directed to a plurality of alleged inventions as follows:

Group A - Claims 1-15 are directed to a method, system and apparatus for managing data across an enterprise;

Group B - Claims 16-21 are directed to a method of chart generation; and

Group C - Claims 22-27 are directed to a method of dossier development.

Canada

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The claims must be limited to one invention only as set out in section 36 of the *Patent Act*.

In view of the above, a search of the prior art has been limited to the subject matter in claims 1-15.

The search of the prior art has revealed the following:

References Applied:

United States Patents

6,012,055	Jan. 4, 2000	G06F 17/30	Campbell et al.
6,240,410	May 29, 2001	G06F 17/30	Wical
6,324,541	Nov. 27, 2001	G06F 17/00	de l'Etraz et al.

Publication

"Business Data Finds a Home on Custom Portals", Techweek	Feb. 22, 1999
Angelica	

Campbell et al. disclose a tool to provide a user a single access point to search widely distributed information. The search results are displayed in both iconographic and textual descriptions of the information, and the user may further cross-reference the search results to find related results.

Wical discloses a method and system for searching through large amounts of documents, where the documents are arranged in categories and a user can browse through the categories looking for the desired information. Also provided are peripheral themes, or categories related to a selected category, which allows a user to search related documents, and a search tool used to locate a specific document.

de l'Etraz et al. disclose a data mining tool that accesses both public and private databases to determine and display relations patterns between entities.

Angelica discloses a review of various industry available enterprise information portals, all of which allow users to organize and search through large amounts of data in disparate repositories.

Obviousness

Claims 1-15 do not comply with section 28.3 of the *Patent Act*. The subject matter of these claims would have been obvious on the claim date to a person skilled in the art or science to which they pertain having regard to any one of Campbell et al., Wical, de l'Etraz et al., or Angelica.

All of the applied references disclose methods for searching for data using multiple, geographically separated, data sources. Users can browse the results to refine the search or

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view particular items returned by the search. The search results are also grouped by subject or category, and cross-referenced to related data items. Thus, the above claims are therefore obvious in view of the applied references.

Non-Statutory Subject Matter

The subject matter of this application is directed to a method of developing dossiers. More specifically, the above claims propose a method of searching for information relating to a client and using this information to prepare a dossier. Although the application recommends using known computing equipment to implement the scheme, and makes general references to databases and software, no new hardware, software, or technology are disclosed. A computer has merely been programmed to perform the various steps of the scheme. This points to the business scheme itself as the focus of this application.

However, creating a client dossier does not produce an essentially economic result in relation to trade, commerce, or industry, in the meaning given those words by the Courts. The Office considers a method to produce an essentially economic result in relation to trade, etc. when that method is a method of operation for an inventive machine or when that method manufactures or constructs a vendible product. Creating client dossiers is not the operation of an inventive machine, nor does it manufacture or build a vendible product. A method that does not produce an essentially economic result in relation to trade, etc. is not a manual or productive art, is therefore not an "art" under section 2 of the *Patent Act*, and is usually labelled by the Courts as a professional skill. The fact that conventional computers and known Internet technology are used to carry out the operations in accordance with the proposed business scheme does not change the nature of the subject matter. As stated by the Supreme Court, the fact that a computer is or should be used does not add to nor subtract from the patentability of a discovery. A method that does not produce an essentially economic result in relation to trade, etc. cannot be made patentable merely by having it carried out by a computer.

Thus, the above claims directed to a mere method of collecting client information, and are non-patentable and cannot be patented under section 2 of the *Patent Act*.

Indefiniteness

Claims 6-10 are indefinite and do not comply with subsection 27(4) of the *Patent Act*. The preamble of these claims recite a computer program. Under Section 2 of the *Patent Act*, a computer related invention as an article of manufacture may be claimed as a computer readable medium having statements or instructions, for execution by a computer, for carrying out the explicitly defined steps of the invention.

Further, claims 6-10 are indefinite for failing to recite any steps to perform the computer implemented method. Code segments that preform various functions are physical or logical entities, and not method steps.

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Claim 11 is indefinite and does not comply with subsection 27(4) of the *Patent Act*. It is unclear why the preamble recites "a system for ... , comprising the steps of ... ". Systems contain functional components or means that operate in a cohesive way. They do not comprise "steps".

Claims 1, 6, and 11 are indefinite and do not comply with subsection 27(4) of the *Patent Act*. The step of "creating links between data items and other data entries in the information repositories according to relationships the data items have to the other data entries" is ambiguous. It is not clear what this step has to do with the preceding steps or how it is related to the rest of the claim. Do the links exist, or are they created, to ease the search? Do the links provide for browsing additional data? Are the links available to a user, or do they exist only internally?

Claims Formalities

Claims 23, 24, 26, and 27 do not comply with subsection 87(2) of the *Patent Rules*. Dependent claims must refer to preceding claims.

In view of the foregoing defects, the applicant is requisitioned, under subsection 30(2) of the *Patent Rules*, to amend the application in order to comply with the *Patent Act* and the *Patent Rules* or to provide arguments as to why the application does comply.

Under subsection 29(1) of the *Patent Rules*, the applicant is requisitioned to provide an identification of any prior art cited in respect of the European Patent Office application describing the same invention on behalf of the applicant or on behalf of any other person claiming under an inventor named in the present application, and the patent number, if granted. Amendment to avoid references cited abroad may expedite the prosecution. In accordance with subsection 29(3) of the *Patent Rules*, if the particulars are not available to the applicant, the reason must be stated.

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